

REMARKS

Claims 15-55 are pending. Applicants have cancelled claims 15 and 18-55 without prejudice and added new claim 56. Claims 16, 17, and 56 will therefore be pending upon entry of the proposed amendments.

The currently pending claims all have priority to Swedish Application Serial No. 0400208-5, filed February 2, 2004. More specifically, new claim 56 is supported, e.g., by the disclosure at page 2, line 27 through page 3, line 2 of the priority document; page 3, lines 6-10 of the priority document; and page 25, line 29 through page 26, line 28 (Example 4) of the priority document. Applicants have amended claims 16 and 17 to depend from claim 56 instead of claim 15 (now cancelled).

The foregoing amendments, which introduce no new matter, are being made for the sole purpose of expediting prosecution of the present application; and Applicants expressly reserve the right to pursue any cancelled subject matter in one or more continuing applications.

Applicants wish to bring to the Office's attention that the compound recited in new claim 56 was elected by Applicants in response to a Restriction Requirement having a notification date of July 9, 2009.

Applicants also wish to bring to the Office's attention that a specific salt of the compound recited in claim 56 is disclosed in PCT application no. PCT/SE2007/000321 in Example 1. This was first brought to the Office's attention in the remarks portion of a preliminary amendment filed on September 14, 2007. Applicants filed a continuation-in-part of PCT/SE2007/000321 on October 3, 2007 (i.e., USSN 11/866,611), which is now abandoned.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 15 and 16 are rejected for allegedly failing to comply with both the written description and enablement requirements of 35 U.S.C. § 112, first paragraph. The recitation of “or solvate thereof, or a solvate of a salt thereof” in claims 15 and 16 appear to be the basis for both grounds of rejection.

Applicants respectfully disagree with the grounds for the rejection; however, to expedite prosecution of the present application, Applicants have cancelled claim 15, thus rendering the rejection moot; and deleted the phrase “or solvate thereof, or a solvate of a salt thereof” from claim 16. In view of the foregoing, Applicants respectfully request that the rejection of claim 16 be reconsidered and withdrawn.

Finally, Applicants respectfully request that the rejection not be applied to new claim 56, which does not recite “or solvate thereof, or a solvate of a salt thereof.”

Rejection under 35 U.S.C. § 112, second paragraph

Claim 15 is rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite. The definition of R³ appears to be the basis for the rejection.

Applicants respectfully disagree with the grounds for the rejection; however, to expedite prosecution of the present application, Applicants have cancelled claim 15, thus rendering the rejection moot.

Applicants respectfully request that the rejection not be applied to new claim 56, which does not recite the language pointed to by the Office in the rejection.

Rejection under 35 U.S.C. § 102

“Claims 15-16, 18-27, 28-30, 34, 36-37(1st), 40-44, 54 are rejected under 35 U.S.C. § 102(e) as being anticipated by US 2005/0107428 (1449) in view of Kenner or Kasende” (Office Action, page 4). According to the Office Action (page 4):

US 2005/0107428 disclosed many compounds wherein the R3 moiety are substituted heterocyclic moieties such as p.72 example 233. If one interprets the above discussed R3 being any heterocyclic moiety with the required pKa range, then inherent anticipation would be found. The oxo-pyrimidone is a tautomer of hydroxyl pyrimidone and the pH recited by Kenner or Kasende for oxo-pyrimidone is within the range of the claims.

Applicants respectfully disagree with the grounds for the rejection; however, to expedite prosecution of the present application, Applicants have cancelled claims 15, 18-27, 28-30, 34, 36-37, 40-44, and 54, thus rendering the rejection of these claims moot.

“US 2005/0107428 (1449) in view of Kenner or Kasende” does not disclose a compound or salt meeting all of the limitations of the compound or salt claimed in new claim 56. As such, Applicants respectfully request that the rejection not be applied to new claim 56. Since claim 16 now depends from new claim 56, it is respectfully submitted that claim 16 is also not anticipated by “US 2005/0107428 (1449) in view of Kenner or Kasende.” In view of the foregoing, Applicants respectfully request that the rejection of claim 16 be withdrawn.

Rejection under 35 U.S.C. § 103

“Claims 15-16, 18-27, 28-30, 34, 36-37(1st), 40-44, 54 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Alcaraz et al. US 2005/0107428 (recited on 1449) in view of Kenner or Kasende” (Office Action, page 5).

Applicants respectfully disagree with the grounds for the rejection; however, to expedite prosecution of the present application, Applicants have cancelled claims 15, 18-27, 28-30, 34, 36-37, 40-44, and 54, thus rendering the rejection of these claims moot.

[1] It is respectfully submitted that the rejection of claim 16 should be withdrawn (and not applied to new claim 56) because US 2005/0107428 does not qualify as prior art under 35 U.S.C. 103(c) against the subject matter claimed in claims 16 and 56 (as well as claim 17, which does not presently stand rejected). This is because:

(i) US 2005/0107428 potentially qualifies as prior art only under one or more of 35 U.S.C. 102(e), (f), or (g); and

(ii) US 2005/0107428 and the present application (i.e., USSN 10/587,633) were, at the time the invention of USSN 10/587,633 was made, owned by the present assignee or subject to an obligation to assign to the present assignee.

[2] US 2005/0107428 is the published version of USSN 10/504,936 (now U.S. Patent 7,709,500), which in turn is the U.S. National Stage of PCT/SE03/00258. Said PCT application published as WO 03/068743 on August 21, 2003. WO 03/068743 does not disclose or suggest a compound or salt meeting all of the limitations of the compound or salt claimed in new claim 56. Thus, without the present specification as a guide, the skilled artisan would not have been led by WO 03/068743 to the specific combination of substituents found in the compound or salt claimed in claim 56. It is therefore submitted that the present claims are patentable over WO 03/068743.

Double Patenting

"Claims 15-16, 18-27, 28-30, 34, 36-37(1st), 40-44, 54 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of USSN 10/504,936 or claim 18 of USSN 11/866,611" (Office Action, page 5).

Applicants respectfully disagree with the grounds for rejection; however, to expedite prosecution of the present application, Applicants have cancelled claims 15, 18-27, 28-30, 34, 36-37, 40-44, and 54, thus rendering the rejection of these claims moot.

It is respectfully requested that the rejection over USSN 11/866,611 be withdrawn because USSN 11/866,611 is now abandoned.

Applicant : Lilian Alcaraz et al.
Serial No. : 10/587,633
Filed : July 28, 2006
Page : 7 of 7

Attorney's Docket No.: 06275-0518US1 / 101318-1P
US/R&I

Applicants will address the rejection of claim 16 over USSN 10/504,936 once claim 16 is otherwise in condition for allowance.

Applicants respectfully request that the rejection over USSN 10/504,936 not be applied to new claim 56. Should the Office apply this rejection to new claim 56, then Applicants will address such a rejection once new claim 56 is otherwise in condition for allowance.

The fee in the amount of \$1,110 for the Three Month Extension of Time is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 06275-0518US1 / 101318-1P US.

Respectfully submitted,

Date: June 17, 2010

/John T. Kendall/
John T. Kendall, Ph.D.
Reg. No. 50,680

Customer Number 26164
Fish & Richardson P.C.
Telephone: (617) 542-5070
Facsimile: (877) 769-7945